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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,846	12/30/1998	KAZUOMI OISHI	35.G2331	2585

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NEW YORK, NY 10112

EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/222,846

Applicant(s)

OISHI, KAZUOMI

Examiner

Douglas J. Meislahn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 04 April 2002 that amended claims 1, 10, 14, 18, 20, and 22. The figures appear are fine.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 18 recites the limitation "completion of encrypting the external encryption key" in the second to last line. There is insufficient antecedent basis for this limitation in the claim. This phrase has been interpreted as saying "completion of encrypting the internal encryption key".

Response to Arguments

5. Applicant's arguments with respect to claims 1-14, 18-20, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 6, 8, 10-14, 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (5535277) in view of Harrison (5870468).

In their abstract, Shibata et al. disclose a scanner section that reads documents, meeting the limitations of applicant's conversion means. The abstract also stipulates that image data is encrypted, reading on the second clause of claim 1. See figure 2 for the key. Shibata et al. do not say that the key is erased when the encryption process is completed. Harrison teaches deleting the key used to encrypt files (which can include images) in elements 18 and 19 of figure 2. As noted in lines 20-22 of column 2, erasure of the encryption key protects the encrypted files.

With respect to claims 18, 20, and 22, Harrison teaches a key encrypting key being input from the outside in element 8 of figure 1. Encrypting data before encrypting the key would be obvious to a person of ordinary skill in the art.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. and Harrison as applied to claim 1 above.

Shibata et al. and Harrison show a system in which images are encrypted, with the encryption key being erased after encryption. They do not say that the key is input from an external source. Official notice is taken that it is old and well-known to receive keys from external sources. One reason for this is that an external source might be more capable of producing secure keys than internal sources. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to send the encryption key to the fax in Shibata et al. from an external source.

9. Claims 7, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. and Harrison as applied to claims 1, 8, and 18 above, and further in view of Schneier.

Shibata et al. and Harrison show a system in which images are encrypted, with the encryption key being erased after encryption. An encrypted copy of the encryption key is maintained. They do not say that the key is encrypted with a key based on public key cryptography. Schneier teaches encrypting keys with public keys on page 48. This securely allows decryption of a key by one recipient. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the key in Shibata et al. and Harrison with a public key as taught by Schneier so as to allow decryption by only one recipient. Encrypting just the message with a public key would also be obvious, especially for small files.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Campbell, Jr. (4605820) – see claim 9.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

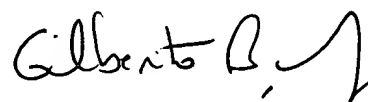
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



DJM

June 16, 2002

Douglas J. Meislahn
Examiner
Art Unit 2132



GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
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